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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,204	11/22/2000	Sam B. Morrison	05725.0642-00	9514

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/05/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/717,204	MORRISON, SAM B.	
	Examin r	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE f this communication appears on the cover sheet with the c rrespondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>18</u> . | 6) <input type="checkbox"/> Other: _____ . |

Claim Rejections 35 U.S.C. 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 and 4-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deslauriers (US 5,221,534, of record), in view of Anton (US 6,063,313, of record), Konik (US 6,060,072, of record) or Kimura (US 4,528,390, of record), and in further view of Mougin et al (US 5,945,095) for the employment of powder in cosmetic composition.

8. Deslauriers teaches a healthy and beauty aid compositions comprising a gel made from blends of di- and triblock copolymers. The gels provide an excellent media or vehicle for delivery of beauty aids (such as mineral oil) to the skin (see, col. 3, lines 7-23). The preferred polymers include those employed herein, e.g., KRATON series of copolymers G1652 (SEBS type). See, particularly, columns 4-5, and column 9, lines 50-68. silicone may be used as solvent of the triblock polymer containing composition. See, column 6, lines 34-40. dimethicone and cyclomethicone are known to be useful with the polymers. See, particularly, table 11 and 17. The health and beauty aid composition may be essentially incorporated with any beauty and health aid ingredients and in various forms, such as makeup, mascara, makeup foundation, etc, which are well-known in the art to comprise powder components. See, particularly, column 6, line 64 to column 7, line 45. The composition may comprise 1-20% of a blend of polymer, 5 to 95% of which is triblock polymer. See, particularly, the claims.

Claim Rejections 35 U.S.C. 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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amount of triblock polymer is within the range disclosed by Deslauriers; Deslauriers' composition is known to be various cosmetic compositions. Further, it would have been obvious to one of ordinary skill in the art to have formulate the composition of Deslauriers by the incorporation the volatile silicones for the ease of formulation imparted by the silicones as taught by Anton, by the addition of trimethylsiloxysilicate and polyethylene polymers for the improved properties of the film-forming agents as taught by Konik, or by the incorporation of polymethylsilsesquioxanes for their anti-caking properties in cosmetic as taught by Kimura. Note in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art," (as in the case of the amount of triblock polymer herein) a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). As to the employment of powders in cosmetic composition, note it is well known in the art that powders are routinely incorporated in to cosmetic compositions such as mascara, makeup foundation. For example, Mougins discloses mascara composition comprising polymeric particles, such as polyethylene. See particularly, column 9, lines 4-65, the example 7, and the claims. Finally, the optimization of a result effective parameter, e.g., eh amounts of known cosmetic agents in a cosmetic composition, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

Response to the Arguments

Applicants' remarks submitted June 9, 2003 have been fully considered, but are not persuasive for reasons discussed below.

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Response to the Arguments

Applicants' remarks submitted June 9, 2003 have been fully considered, but are not persuasive for reasons discussed below.

Applicants argue that the particular amount of triblock polymer herein recited (0.139% to 1.953%) is not obvious to Deslauriers' disclose which recites 1-20% of a blend of polymers, 5-95% of which is triblock polymer. The arguments are not persuasive. As stated above, "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped.); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997)." Further, even the preferred range of Deslauriers (5-15%) would cover the claimed range, considering the percentage of triblock polymer in the blend (5-95%).

As to claim 29, which requires linear dimethicone, cyclic dimethicone and block copolymers, applicants' argue that Deslauriers teaches, cyclic dimethicone or linear dimethicone are tested to be the worst emollients. The arguments are not persuasive. First the examples disclosed in table 11 is test for emollient which show both linear and cyclic dimethicone is suitable for a particular gel (formed with Drakeol 5) at least in the range be low 10% for linear dimethicone, and less than 50% for cyclic dimethicone. There is no indication that dimethicone may not be used as emollients in triblock copolymer-containing cosmetic composition, or that the dimethicones (linear or cyclic) may not be used as volatile solvents as suggested by Anton.

As to the recited powders of claim 27 and 28, note since Deslauriers teaches that the health and beauty aid composition may be employed in various cosmetic composition. It would

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be obvious to employ the composition in a cosmetic composition such as mascara or makeup foundation, which powders are routinely employed. See Mougin et al.

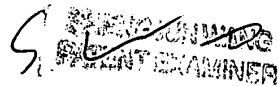
With respect to the employment of dimethicone in the amounts as cited in claim 31, applicants' attention is directed to Anton, wherein volatile dimethicone is disclosed as particular useful as solvent or diluent. As discussed above Deslauriers does not teach or suggest that volatile dimethicone as disclosed by Anton may not be used with the triblock polymer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner



Shengjun Wang

September 2, 2003